UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,425	05/24/2001	Andrew J. Vilcauskas JR.	Exit:Post1	5992

152 7590 12/06/2004

CHERNOFF, VILHAUER, MCCLUNG & STENZEL
1600 ODS TOWER
601 SW SECOND AVENUE
PORTLAND, OR 97204-3157

EXAMINER	
WASSUM, LUKE S	

ART UNIT	PAPER NUMBER
2167	

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/866,425	VILCAUSKAS ET AL.	
	Examiner	Art Unit	
	Luke S. Wassum	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 August 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20040820*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Preliminary Amendment

1. The Applicants' amendment, filed 20 August 2004, has been received, entered into the record and considered.

2. As a result of the amendment, claims 21, 23 and 33 have been amended. Claims 21-40 remain pending in the application.

Priority

3. The Applicants' claim to domestic priority under 35 U.S.C. §119(e), to provisional application 60/207,698, filed 26 May 2000, is acknowledged. Since the subject matter of the parent provisional application encompasses that of the instant application and claims, a priority date of 26 May 2000 is hereby established.

The Invention

4. The claimed invention is drawn to a method of presenting advertisements in a computer system through the use of popunder windows. Alternative claimed embodiments are implemented in other media, such as a PDA, telephone, television and radio.

Information Disclosure Statement

5. The Applicants' Information Disclosure Statement, filed 20 August 2004, has been received and entered into the record. However, the Information Disclosure Statement fails to comply with

the provisions of MPEP § 609, and particularly 37 C.F.R. § 1.98(a)(2), which requires a copy of each cited foreign patent and each cited non-patent document. Additionally, a number of the cited U.S. Patent documents contained typographical errors (the examiner presumes) in the patent numbers, as evidenced by inconsistencies between the cited patent numbers and patentees.

Two attempts by the examiner to secure copies of the references by contacting attorney Kevin L. Russell were unsuccessful.

U.S. Patents without typographical errors in the cited patent numbers have been considered. Foreign patents and non-patent documents cited will be considered only upon submission of copies of said references to the Office.

See attached form PTO-1449.

Claim Objections

In view of the amendments to claims 23 and 33, the examiner withdraws the pending claim objections.

Claim Rejections - 35 USC § 112

6. In view of the amendment to claim 21, the examiner withdraws the pending claim rejection under 35 U.S.C. § 112.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham* v. *John Deere Co*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 21-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Landsman et al.** (U.S. Patent Application Publication 2003/0004804) in view of **Porn Rodeo** ("source code of www.pornrodeo.com as of 13 October 1999").

11. Regarding claim 21, **Landsman et al.** teaches a system for Internet advertising for use in a media capable of simultaneously maintaining a foreground window and at least one background window and capable of displaying a first browser in a said foreground window for selectively browsing the Internet substantially as claimed, said system comprising:

a) a script handler that invokes a post-session procedure in said first browser (see disclosure that HTML advertising tags are embedded in a web page, Abstract; see also Figures 2A and 2B); and

b) an event handler that receives, from an Internet address, a link to an advertisement and loads said advertisement (see paragraphs [0003], [0016], [0017], [0036]-[0038], [0087], [0095], [0107] and [0109]).

Landsman et al. does not explicitly teach a system wherein said post-session procedure opens a second browser in a background window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window.

Porn Rodeo, however, teaches a system wherein said post-session procedure opens a second browser in a background window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window (see window.open and window.focus calls on page 1, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to open a browser in the background and load the advertisement directly into the browser, since this

would allow the display of the advertisement to the user (by moving the browser window to the foreground) without the need to open a new window, load any required player files, and load and render the advertisement, thus speeding the display of the advertisement to the user.

12. Regarding claim 31, **Landsman et al.** teaches a post-session advertising method for use in media capable of simultaneously maintaining a background window and a foreground window, said method comprising the steps of:

a) embedding post-session instructions into a first browser, said first browser for being displayed in said foreground window (see disclosure that HTML advertising tags are embedded in a web page, Abstract; see also Figures 2A and 2B);

b) said post-session instructions receiving, from an Internet address, a link to an advertisement (see discussion of a request for, and receipt of, an AdDescriptor file, a text file containing a list of file names and corresponding URLs at which these files reside, paragraphs [0103] through [0107]); and

c) loading said advertisement (see paragraph [0107]).

Landsman et al. does not explicitly teach a method wherein said post-session instructions open a second browser in a background window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window.

Porn Rodeo, however, teaches a method wherein said post-session procedure opens a second browser in a background window while said first browser is simultaneously displayed in said

foreground window, and wherein said advertisement is loaded into said second browser in said background window (see window.open and window.focus calls on page 1, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to open a browser in the background and load the advertisement directly into the browser, since this would allow the display of the advertisement to the user (by moving the browser window to the foreground) without the need to open a new window, load any required player files, and load and render the advertisement, thus speeding the display of the advertisement to the user.

13. Regarding claims 22 and 32, **Porn Rodeo** additionally teaches a system and method wherein said second browser is opened in response to a load-triggering event (see window.open call on page 1, lines 16-17, showing that the load-triggering event was the loading of the porn rodeo web page).

14. Regarding claims 23 and 33, **Porn Rodeo** additionally teaches a system and method wherein said load-triggering event comprises at least one of clicking on an off-site link, entering a new address, refreshing a web site, exiting a web site, and being redirected to a web site (see window.open call on page 1, lines 16-17, showing that the load-triggering event was the loading of the porn rodeo web page, analogous to both refreshing a web site and being redirected to a web site, since both would entail the loading of the web page).

15. Regarding claims 24, 25, 34 and 35, **Landsman et al.** additionally teaches a system and method wherein said script handler delays invocation of said post-session procedure for a predetermined period of time, and wherein said script handler cancels invocation of said post-

session procedure if a user loads a new web site in said first browser before said predetermined time period has elapsed (see disclosure of the timer based frame targeted advertisements, paragraph [0159]).

16. Regarding claims 26 and 36, **Landsman et al.** additionally teaches a system and method wherein said second browser is displayed in a foreground window after the occurrence of a view-triggering event (see paragraphs [0037] and [0038]).

17. Regarding claims 27 and 37, **Landsman et al.** additionally teaches a system and method including a focus timer that tracks the duration that said second browser is displayed in said foreground window (see paragraph [0050]).

18. Regarding claims 28 and 38, **Landsman et al.** additionally teaches a system and method wherein said media comprises one of a computer, a PDA, a cell phone and a television (see disclosure that the system is executed in a computer, Abstract).

19. Regarding claims 29 and 39, **Landsman et al.** additionally teaches a system and method wherein said event handler selects and returns one of a plurality of advertisements maintained at said Internet address (see paragraph [0104]).

20. Regarding claims 30 and 40, **Porn Rodeo** additionally teaches a system and method capable of opening a plurality of second browsers, each maintained in a separate background window, said event handler capable of receiving a link to an advertisement for each browser and loading a

respective said advertisement into each said second browser while each said second browser remains in its respective said background window (see window.open and window.focus calls on page 1, lines 15-20, code that would open an additional background window each time the web page was refreshed).

Response to Arguments

21. Applicant's arguments filed 20 August 2004 have been fully considered but they are not persuasive.

22. Regarding the Applicants' arguments that the **Landsman et al.** reference is not amenable to a combination with the **Porn Rodeo** reference, the examiner respectfully disagrees.

The Applicants argue that the **Landsman et al.** reference teaches a system wherein advertisements are prepared and held in a queue until it is ready to be displayed, and that this precludes combination with the **Porn Rodeo** reference. The examiner responds that the motivation for one of ordinary skill in the art to preload an advertisement into a background window (as is taught by the **Porn Rodeo** reference) is set out in the rejection of record. Preloading the first advertisement in the queue when the downloading of the advertisement has completed would not preclude the storage of additional advertisements in the queue, and would not require the window to contain a queue of advertisements. The examiner maintains the rejections of record.

23. Regarding the Applicants' argument that neither of the references teaches a mechanism to move the background window to the foreground, the examiner respectfully points out that the

relevant claimed limitation is that "said second browser [in the background] is displayed in a foreground window after the occurrence of a view-triggering event", see claims 26 and 36.

On page 17 of the specification, the Applicants disclose that

> Exemplary view triggering events could include clicking on an off-site link or entering a new address in a dialogue box, load, unload, click, resize, submit, focus, blur, drag, key press (including a mouse button key), select, change (contents of a field), refresh, open, close, redirect, enter, exit, maximize, end of program, beginning of program, beginning of session, end of session, "switching services," or change of service. Still other view triggering events may be time controlled. These view triggering events are meant to be exemplary.

Thus, in the claimed invention, a number of the disclosed exemplary view triggering events, such as close and exit, would result in the background window being displayed in the foreground. This would also be the case if such view-triggering events were to occur in the combined **Landsman et al.-Porn Rodeo** prior art. Closing or exiting the foreground window would expose the background window, thus displaying said second browser in a foreground window, as claimed.

The examiner maintains the rejections of record.

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Landsman et al. (U.S. Patent 6,785,659) teaches a technique for implementing in the Internet, network-distributed advertising in which advertisements are downloaded from an advertising server to a browser in a manner transparent to the user.

Landsman et al. (U.S. Patent Application Publication 2002/0120666) teaches a technique for implementing in the Internet, network-distributed advertising in which advertisements are downloaded from an advertising server to a browser in a manner transparent to the user.

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30; alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luke S. Wassum
Primary Examiner
Art Unit 2167

lsw
29 November 2004